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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,951	01/18/2006	Noboru Uenishi	049677-0176	5407
20277	7590	12/12/2007	EXAMINER	
MCDERMOTT WILL & EMERY LLP			LAVILLA, MICHAEL E	
600 13TH STREET, N.W.			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005-3096			1794	
			MAIL DATE	DELIVERY MODE
			12/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/564,951

**Applicant(s)**

UENISHI ET AL.

**Examiner**

Michael La Villà

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
  2. A person shall be entitled to a patent unless –
  3. the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
4. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Uenishi et al. JP 2003-217375. Uenishi et al. teaches a cadmium free silver/indium/tin alloy two-layered contact, wherein the first layer possesses the claimed hardness and thickness and wherein the second layer possesses the claimed hardness. See Uenishi et al. (Abstract; Table 1; paragraphs 6, 7, 10-12, and 15-33).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  6. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  8. Determining the scope and contents of the prior art.
  9. Ascertaining the differences between the prior art and the claims at issue.
  10. Resolving the level of ordinary skill in the pertinent art.
  11. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uenishi et al. JP 2003-217375. Uenishi et al. teaches a cadmium free silver/indium/tin alloy two-layered contact, wherein the first layer possesses the claimed hardness and thickness and wherein the second layer possesses the claimed hardness. See Uenishi et al. (Abstract; Table 1; paragraphs 6, 7, 10-12, and 15-33). To the extent that Uenishi et al. may not exemplify the claimed second layer hardness, it would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate the contact of Uenishi with the claimed hardness value for the second layer as Uenishi suggests that second layer hardness values of 130 are effective.

***Response to Amendment***

13. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 28 June 2007. Rejection is withdrawn.

14. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Uenishi and the section 103 rejection over Uenishi of the Office Action mailed on 28 June 2007. Applicant's traversal is predicated on perfecting applicant's priority claim, rendering Uenishi as unavailable prior art. Applicant's translated priority document has been reviewed. However, the invention as claimed does not appear to find support in the priority document. Particularly, with respect to Claim 1, the claimed second layer average hardness requirement of more than 130 in combination with the other claimed limitations was not apparently supported textually, and applicant has provided no other justification for support. With respect to Claim 4, the claimed elements of Cu, Mo, W, and Ge, in combination with the other claimed limitations, was not apparently supported textually, and applicant has provided no other justification for support. It is remarked that applicant has not

provided any explanation of antecedent support for any claim and/or limitations. Since the priority document has not been demonstrated to provide support for the invention as claimed, Uenishi remains available prior art, and so the rejections are maintained.

***Allowable Subject Matter***

15. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
16. The subject matter of Claims 9 and 10 is not taught or suggested by the reviewed prior art. Particularly, the claimed structural arrangement in combination with the other claimed limitations is not taught or suggested.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

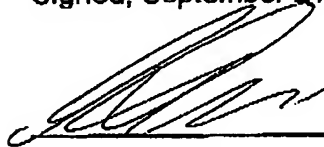
Michael La Villa  
30 November 2007

  
MICHAEL E. LAVILLA PH.D.  
PRIMARY EXAMINER



I, Kumiko Kawai of Tranomon East Building, 7-13, Nishi-Shimbashi 1-chome, Minato-ku, Tokyo 105-8408, Japan, hereby declare that I am conversant with the Japanese and the English languages and that I am the translator of the document attached and certify that to the best of my knowledge and belief the following is a true and correct English translation of the specification contained in the Japanese Patent Application No. 2003-199389.

Signed, September 21, 2007



Kumiko Kawai

Patent Department

*considered  
11/30/07  
me*